

## REMARKS

Claims 1-20 are pending and are currently under examination. Claim 21 has been added. Claim 4 has been amended to better conform with U.S. patent practice. Claim 1 has been amended herein. Support for the amendment to claim 1 can be found throughout the specification and also in Figure 3. No new matter has been added.

## Rejections

- (1) Claim 4 was rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated that he was “unclear to the limitation the applicant is trying to present in the claim” by the phrase “and a hollow spherical cap” (Office Action, page 2, items 3-5).
- (2) Claims 1-6 and 19-20 were rejected as allegedly anticipated under 35 U.S.C. § 102(e) by Huebner et al. (U.S. Pub. No. 2004/0127901, which published July 01, 2004 and originated as a U.S. application filed July 22, 2003 (“Huebner-901”).
- (3) Claims 7-18 were rejected as allegedly obvious under 35 U.S.C. § 103(a) as follows:
  - Claim 7: Huebner et al., U.S. Pub. No. 2004/0127901 (“Heubner-901”) in view of Huebner et al., U.S. Pub. No. 2004/0102778 (“Huebner-778”)
  - Claim 8 and 13-18: Heubner-901 in view of Huebner-778, in view of Weiss et al., U.S. Pat. No. 6,179,839 (“Weiss-839”)
  - Claims 9 and 12: Heubner-901 in view of Huebner-778 in view of Weiss-839, in view of McGuire et al. U.S. Pat. No. 5,374,270 (“McGuire-270”)
  - Claims 10 and 11: Heubner-901 in view of Huebner-778 in view of Weiss-839, in view of Griner et al., U.S. Pub. No. 2004/0039450 (“Griner-450”).

## Responses

### Response to Rejection (1)

Claim 4 has been amended to clarify the recitation “hollow spherical cap.” Claim 4 now recites: “The osteosynthesis plate according to claim 3, wherein said recess occupies a portion of said face of the plate opposite to that coming into contact with the bones to be treated, and wherein the recess is in the form of a hollow spherical cap.” Support for the amendment can be found, for example, on page 1, paragraph 14. Applicants respectfully request reconsideration and withdrawal of this rejection.

### Response to Rejection (2)

According to the Office Action (see pages 3-4 and Figures 2 and 3) Figures 3 and 9 in Huebner-901 depict a bone plate that falls within the scope of the claim 1. Applicants respectfully disagree with the assertion for at least the following reason.

In order for Huebner-901 to qualify as prior art within the meaning of 35 U.S.C. § 102(e) it must teach every element of the claim, see, e.g. MPEP § 2131. Huebner-901 fails to teach each and every limitation of claims 1-6 and 19-20 as detailed below.

Claim 1 of the present application recites:

An osteosynthesis plate for osteosynthesis of wrist bones configured to be placed above bones to be treated, without resting on larger neighboring bones, and comprising

(a) a bone-contacting surface; and

(b) lateral holes for inserting screws to fix said screws to such bones to be treated, wherein the entire bone-contacting surface is flat, and wherein said bone-contacting surface comprises holes for receiving screws having axes that are tilted in relation to said flat bone-contacting surface, such holes being designed such that the screws, once inserted into said holes, diverge towards an outside face of the plate (*emphasis added*).

Figure 3 in Huebner-901 depicts a bone plate having a body portion (30) and a substantially hemi-spherical (convex) bone facing surface (46). Huebner-901 states that “[c]onvex, as used herein, means that the surface bulges generally outward so that it can be received in a bone recess” (Huebner-901, page 4, paragraph 37). Accordingly, the entire bone-contacting surface in Figure 3 of Huebner-901, is not flat.

Figure 9 in Huebner-901 depicts a bone plate (210), having a lateral region (234) whose bone facing surface has a convex projection (242) extending vertically from its central region beyond the plane of the plate. The entire bone-contacting surface of the lateral region (234) of the bone plate (210) is not flat because a portion of the bone-contacting surface of the lateral region (242) of the plate (210) has a convex projection (242) extending from the surface vertically relative to plane lateral region (242). Accordingly, the entire bone-contacting surface of the bone plate (210) depicted in Figure 9 in Huebner-901 is not a flat surface.

Applicants respectfully submit that with respect to claim 1 and all the dependent claims, Huebner-901 fails to disclose “an osteosynthesis plate...wherein the entire bone-contacting surface is flat...” For at least this reason, Applicants contend that Huebner-901 fails to anticipate claim 1. Applicants respectfully request that the rejection to claims 1-6 and 19-20 be reconsidered and withdrawn.

### Response to Rejection (3)

For a reference or a combination of references to support a prima facie case of obviousness within the meaning of 35 U.S.C. § 103(a) three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference or combination of references must teach or suggest all the claim limitations, see, e.g. MPEP § 2142. The cited references, either alone or in combination, fail to teach each and every limitation of claims 7-18.

With regard to the main reference, Huebner-901, Applicants assert above that this reference does not teach or suggest a bone facing surface that is entirely flat. Further, Huebner-

901 does not teach or suggest that an entirely flat bone-contacting surface would be beneficial or advantageous over the hemi-spherical bone facing surfaces taught therein. Huebner-901 teaches either hemi-spherical bone facing surfaces, or bone facing surfaces having a convex protrusion. The entirely flat bone-contacting surface according to the present invention has advantages over bone plates having bone-contacting surfaces that are conical or hemi-spherical such as those described in Huebner-901. Advantageous features of an entirely flat bone-contacting surface include (1) the osteosynthesis plate can be affixed directly to the bones to be treated, (2) the plate does not rest on larger neighboring bones, and (3) bone screws are inserted directly into bones to be treated instead of between bones or other bones not being treated. Therefore, the main reference, Huebner-901, cannot render claims 7-18 obvious.

With respect to claim 7, the combination of Huebner-901 and Huebner-778 does not overcome the deficiency of Huebner-901 of failing to teach an entirely flat bone-contacting surface. Therefore, claim 7 is not obvious in view of this combination.

Further, with respect to claims 8 and 13-18, the combination of Huebner-901 and Huebner-778 and Weiss-839 also fails to overcome the deficiency of Huebner-901 of failing to teach an entirely flat bone-contacting surface. Therefore, claims 8 and 13-18 are not obvious in view of this combination.

With respect to claims 9 and 12, the combination of Huebner-901, Huebner-778, Weiss-839 and McGuire-270 also fails to overcome the deficiency of Huebner-901 of failing to teach an entirely flat bone-contacting surface. Therefore, claims 9 and 12 are not obvious in view of this combination.

With respect to claims 10 and 11, the combination of Huebner-901, Huebner-778, Weiss-839 and Griner-450 also fails to overcome the deficiency of Huebner-901 of failing to teach an entirely flat bone-contacting surface. Therefore, claims 10 and 11 are not obvious in view of this combination.

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In sum, Applicants respectfully submit that the teachings of Huebner-901, Huebner-778, Weiss-839, McGuire-270 and Griner-450, separately or in combination with one another, fail to disclose or suggest the inventive embodiments that are recited in pending claims 7-18. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections of these claims.

**Conclusion**

Applicants believe the claims are now in condition for allowance. An early Notice of Allowance is therefore earnestly solicited. Applicants invite the Examiner to contact the undersigned at (215) 963-5265 to clarify any unresolved issues raised by this response.

Respectfully submitted,



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